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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/468,611	12/21/1999	ERIC B. REMER	42390.P7278	3835

7590   02/25/2003

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EXAMINER
HAYES, JOHN W

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 02/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>24 December 2002</u> .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-10,13 and 25-34</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-10,13 and 25-34</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>21 December 1999</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)   4)☐ Interview Summary (PTO-413) Paper No(s). _____ .

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)   5)☐ Notice of Informal Patent Application (PTO-152)

3)☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5,10</u> .   6)☐ Other: .

DETAILED ACTION

Continued Prosecution Application

1. The request filed on 24 December 2002 for a Continued Prosecution Application (CPA) under 37

CFR 1.53(d) based on parent Application No. 09/468,611 is acceptable and a CPA has been established.

An action on the CPA follows.

Status of Claims

2. Applicant has previously canceled claims 11-12 and 14-24. Also, applicant has amended claims 1, 3-

5, 7-8, 10, 13, 26-32 and added new claims 33-34 in the amendment filed 03 December 2002. Thus,

claims 1-10, 13 and 25-34 remain pending and are presented for examination.

Response to Arguments

3. Applicant's arguments with respect to the claims have been considered but are moot in view of the

new ground(s) of rejection.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections

set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-10, 13 and 25-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Misra et

al, U.S. Patent No. 6,189,146 B1 in view of Gradient, "Gradient Introduces End User Software License

Creation and Delivery Tool For Its iFOR/LS Licensing Technology, dated 21 March 1994.

As per **Claims 1, 13 and 33-34**, Misra et al discloses a method for licensing software comprising:

- generating a first license for software installed on the first computer, the first license valid for a first predetermined period of time stored on the first computer (Col. 2, lines 62-67; Col. 3, lines 22-25; Table 1; Col. 11, lines 45-51; Col. 12, lines 8-14)

- generating on a second computer a second license for the installed software, the second license valid for a second predetermined period of time (Col. 2, lines 48-55; Col. 8, lines 35-67; Table 3; Col. 9, lines 29-36; Col. 13, lines 61-63)

- obtaining from the second computer the second license (Col. 4, lines 54-59; Col. 12, lines 20-27; Col. 14, lines 8-14 and 49-53)

- replacing a first license with the second license (Col. 16, lines 49-67)

- selectively refreshing the second license prior to expiration of the second predetermined period of time (Col. 14, lines 14-51; Col. 16, lines 49-67).

Misra et al discloses the generation of a first license on a license generator computer which is the same license generator that generates the second license as well, however, fail to explicitly disclose that a first computer generates the first license. Gradient discloses a license delivery and installation tool the enables end users to create software licenses on their own system without outside intervention and further teach that end users can create their own "try and buy" demo licenses for software and later, if the user chooses to purchase an operational license, the desired license type may be selected from an options menu and installed. Gardient teaches that authorized end users are able to instantly create short-term licenses and allows end users, working at their own PC, to select from a variety of licensing options and to create licenses that are installed within a single user's workstation or PC. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Misra et al and include the ability to allow a first computer such as a end user to create their own license and store this license on the first computer wherein the license is valid for a predetermined short-term period of time as taught by Gradient. Gradient provides motivation by indicating that this capability revolutionizes the economics of software fulfillment and licensing and offers advanced tools that lower the

cost of license creation and delivery and further provides end users with complete control over their

software purchase and deployment decisions.

As per **Claims 2 and 25**, Misra et al further disclose wherein the first and second licenses each

share a unique identifier to associate the first and second licenses with the first computer (Col. 9, lines

29-61; Col. 10, lines 51-59; Col. 12, lines 47-67)

As per **Claims 3, 10, 26 and 32**, Misra et al further disclose wherein the first and second licenses

are digitally signed (Col. 13, lines 42-63; Col. 14, lines 25-38).

As per **Claims 4 and 27**, Misra et al further disclose wherein obtaining from the second computer

the second license further comprises:

- connecting to the second computer (Col. 14, lines 14-16)

- providing the second computer with at least some of the data from the first license (Col. 14,

lines 24-30)

- exchanging the provided data from the first license for the second license (Col. 14, lines 49-53;

Col. 15, lines 11-18 and 37-49).

As per **Claims 5-6 and 28-29**, Misra et al further disclose wherein connecting to the second

computer comprises connecting to the second computer via a communications network (Col. 4, lines 43-

49).

As per **Claim 7,** Misra et al disclose all the limitations of claim 5, however, fail to specifically

disclose wherein exchanging the first license for the second license includes formatting data from the first

license according to a set of text processing rules and transmitting the formatted data using a text transfer

protocol. Examiner takes Official Notice that formatting data according to a set of text processing rules

such as HTML or XML and transmitting the formatted data using a text transfer protocol such as HTTP

was well known in the art at the time of applicants invention. Thus, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to use text processing rules such as HTML for formatting data and use a text transfer protocol such as HTTP for exchanging data since these formats and protocols were commonly used, especially in Internet communications since they were readily available and convenient to use.

As per **Claims 8 and 30**, Misra et al further discloses wherein replacing the first license with the second license further comprises:

- matching the unique identifier of the second license to the unique identifier of the first license, and if no matching occurs, discarding the second license without replacing the first license (Col. 11, lines 45-65; Col. 11 line 66-Col. 12 line 7; Col. 14, lines 30-39), and

- authenticating the digital signature of the second license, and if authentication fails, discarding the second license without replacing the first license (Col. 12, lines 8-15).

As per **Claims 9 and 31**, Misra et al disclose verifying whether the replaced license is valid, including determining whether the replaced license has expired (Col. 14, lines 30-48).

Conclusion

6.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

• Horstmann discloses that an end user's machine is installed with a license certificate which typically is installed during original installation of a software product and further including a relicensing manager

7.   The prior art previously made of record and not relied upon is considered pertinent to applicant's disclosure.

• Ross et al disclose a method and apparatus for electronic licensing in a network environment to facilitate product licensing and upgrades

- Coley et al disclose an automated system for management of licensed software and enabling or disabling the software accordingly

- Griswold discloses a license management system that periodically invokes a license check monitor to ensure valid usage of software and terminates use of the software is appropriate

- Horstmann discloses a method of relicensing of electronically purchased software

- Knutson discloses a method for licensing computer programs using DSA signature

- Carter et al disclose a method for network license authentication

- Cohen discloses a method for software licensing electronically distributed programs

8.   Any inquiry concerning this communication or earlier communications from the examiner should

be directed to John Hayes whose telephone number is (703)306-5447. The examiner can normally be

reached Monday through Friday from 5:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim

Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be

directed to the receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington D.C. 20231
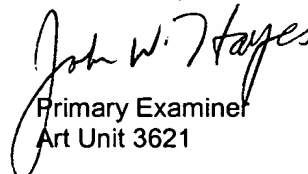
or faxed to:

(703)305-7687   [Official communications; including
                    After Final communications labeled
                    "Box AF"]

(703) 746-5531   [Informal/Draft communications, labeled
                    "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington,
VA, 7th floor receptionist.

John W. Hayes

Primary Examiner
Art Unit 3621

February 22, 2003